REMARKS

35 U.S.C. §112

The examiner rejected Claims 15, 27 and 31 under 35 U.S.C. 112, second paragraph as the limitations "the merged list" lacked antecedent basis and that Claims 20 and 28 "the second list" lacked antecedent basis.

Claims 15, 27 and 31 do not recite "the merged list."

Clarification of this rejection is requested.

Claims 20 and 28 have antecedent basis for the second list. Each of these claims recite "a second list of offers." One of skill in the art would understand this to provide antecedent basis for "the second list."

Nevertheless, to advance prosecution, the claims have been amended.

35 U.S.C. §102

The examiner rejected Claims 1-5, 7-8, 15, 20-21 and 27-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Kepecs (US 2001l0032128).

Claim 1 has been amended to recite: "generating by the computer an ordered list of offers, by which to contact a potential customer from the group of potential customers, the offers in the ordered list of offers selected from the set of offers, ... by considering an expected, composite profit of combinations of the offers for each the potential customer independently from expected, composite profit of combinations of the offers for others of the potential customers ... ordering ... offers in the list ... according to the expected profit, repeating generating ... for subsequent ... potential customers to produce corresponding ordered lists; and producing ... a second list of offers ... from the ordered lists ... with the second list based upon a budget for contacting the potential customers in the group."

The complete text of the examiner's rejection can be found in the office action. Applicant will deal with the examiner's further explanations found in the examiner's Response to Arguments.

The examiner reasons that the feature of "assigning offers by the computer based on individual attributes of the potential customer independently of corresponding attributes of others of the potential customers in the group" is found in Kepecs paragraphs 27 and 96. Applicant has removed this feature and instead has subsumed that feature within the generating step that generates an ordered list of offers by considering an expected, composite profit of combinations of the offers for each potential customer independently from expected, composite profit of combinations of the offers for other potential customers. The examiner refers to these teachings in Kepecs as "**offers are customized for each individual consumer based on the particular consumer's attributes such as purchase or shopping history and the consumer response to the offers.**"

Kepecs teachings pertaining to customization of offers does not relate to the generating of the ordered lists of offers, as recited in claim 1. Kepecs does not assign offers to an ordered list based on "… an expected, composite profit of combinations of the offers for each potential customer independently from expected, composite profit of combinations of the offers for others of the potential customers in the group of potential customers … ."

Initially, Kepecs does not select offers from a set of offers. Kepecs describes: "Since offers are customized on a per consumer (or per household) basis, an offer is distributed or made accessible only to the consumer for whom the offer is customized. In this manner, the present invention achieves actual one-to-one marketing of offers."

Kepecs also does not generate ordered list based on expected composite profit of combinations of offers. Rather, as set out below in Kepecs, priorities that are associated with offers are based on product attributes.

Moreover, while expected profit is not a product attribute and is not considered by Kepecs in assignment of offers, Kepecs clearly does not describe or suggest to assign offers to an ordered list based on an expected, composite profit of combinations of the offers for each potential customer independently from expected, composite profit of combinations of the offers for others of the potential customers.

[0061] YME module **120** may also associate priorities with offers. These priorities influence the manner in which arbiter **122** selects offers to be distributed/advertised to the consumer. For example, a priority value ("special" priority) may be associated with an offer instructing arbiter **122** to always select the offer. Priorities may also be assigned according to a sliding rule scale, such that offers with higher priorities assigned to them are more likely to be selected than offers with lower priorities associated with them. Further, multiple priorities of different types may be assigned to the same offer or may be used to determine the priority for the offer.

[0062] According to an embodiment of the present invention, an incented-product priority value, a tactic priority value, and a depth of discount priority value may be assigned to an offer and may be used to calculate the composite priority (may be calculated by arbiter **122**) for the offer. For example, the following formula may be used to determine the offer priority:

$$incented\text{-}product\ priority + tactic\ priority + (\%\ discount)/10 = offer\ priority$$

[0063] In addition to the priority information, other information related to the product, such as the type of product, may also be used by arbiter **122** in the offer selection process. For example, within the top priority set, perhaps only a few "high visibility" products could be selected, so that some lower priority products with less brand visibility might be included in the selected set of offers which arbiter **122** deems desirable to display to the consumer. The set of offers not chosen by arbiter **122** may be relayed back to YME module **120** so that these offers are not enabled at the POS. Further details related to selection of offers by arbiter **122** are provided below.

The examiner reasons that the feature of "repeating generating for subsequent others of the potential customer to produce corresponding ordered lists" is found in Kepecs as "generating a sorted list of offers for a customer (see paragraph 66)." However, in paragraph 66 Kepecs does not teach the feature of "repeating generating ... for subsequent others ... to produce corresponding ordered lists based on expected, composite profit of combinations of the offers ...

independently from expected, composite profit of combinations of the offers for others of the potential customers ... ," but instead teaches to generate a sorted list of offers for a customer. However, the generating of corresponding ordered lists feature of claim 1 is as with the generating feature based "expected, composite profit of combinations of the offers for the subsequent potential customers independently from expected, composite profit of combinations of the offers for others of the potential customers in the group of potential customers."

To the extent that [0066] can be construed to teach "repeating generating" of some list, it does not suggest the claimed "generating of ordered lists."

The examiner reasons that the feature of "producing by the computer a second list of offers that is a list provided from the ordered lists of offers from the one and subsequent others of the potential customers, with the second list based upon a budget for contacting the potential customers in the group. The examiner reasons that:

> "Kepecs's system can use a GUI (see figure 6) to create a first list of offers with for example, by setting Budget parameters to zero (see shown in figure 6, paragraph 93), and print said first list of offers (see paragraphs 45-46) and then later create a second list of offers by setting budget parameters not to zero and print said second list of offers.
> Said second list of offers would be a truncated version of the first list of offers due to budget constraints.

Applicant disagrees that the examiner's scenario (not described or suggested by Kepecs but created by the examiner) would read on the generating feature.

The generating feature requires: "producing by the computer a second list of offers that is a list provided from the ordered lists of offers from the one and subsequent others of the potential customers, with the second list based upon a budget for contacting the potential customers in the group." Printing two different lists based on Fig. 6 of Kepecs would not meet the claim feature that requires that the second list of offers is produced by the computer from the ordered lists of offers from the ... potential customers."

Therefore, Kepecs would not suggest, much less describe this feature. Applicant reminds the examiner that: "Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983). The features set forth above are not described by Kepecs and the examiner's scenario is certainly not described by Kepecs. Accordingly Kepecs cannot anticipate claim 1.

Independent claims 7, 20 and 28 each include at least the combination of the features of: (for claim 28) instructions to: "generate an ordered list of offers to be sent to a potential customer in a group of potential customers, with offers selected from a set of offers and ordering being based on expect composite profit of combinations of offers; generate ordered lists for subsequent others of the potential customers, with offers selected from a set of offers and ordering being based on expect composite profit of combinations of offers."

Accordingly these claims are also allowable over Kepecs.

35 U.S.C. §103

The examiner rejected Claim 6 under 35 U.S.C. 103(a) as being unpatentable over Kepecs (US 2001 100321 28).

Claim 6 is allowable over Kepecs for reasons discussed in claim 1 and reasons of record, as applicable.

The examiner rejected Claims 9-14, 16-19, 22-26 and 29-30 under 35 U.S.C. 103(a) as being unpatentable over Kepecs (US 200110032128) in view of Galperin (US 6,993,493).

Claims 9-14, 16-19, 22-26 and 29-30 are allowable over Kepecs for reasons discussed in conjunction with their respective base claims and reasons of record, as applicable.

It is believed that all the rejections and/or objections raised by the examiner have been addressed.

In view of the foregoing remarks, applicant respectfully submits that the application is in condition for allowance and such action is respectfully requested at the examiner's earliest convenience.

All of the dependent claims are patentable for at least the reasons for which the claims on which they depend are patentable.

Canceled claims, if any, have been canceled without prejudice or disclaimer.

Any circumstance in which the applicant has (a) addressed certain comments of the examiner does not mean that the applicant concedes other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the applicant concedes any of the examiner's positions with respect to that claim or other claims.

No fee is due. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: September 23, 2010   /Denis G. Maloney/
                                                Denis G. Maloney
                                                Reg. No. 29,670

Customer Number 26161
Fish & Richardson P.C.
Telephone: (617) 542-5070
Facsimile: (877) 769-7945

22496049.doc